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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,581	01/27/2004	Akio Uchiyama	17406	3837
23389 7590 02/17/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
KASZTEJNA, MATTHEW JOHN				
ART UNIT		PAPER NUMBER		
3739				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/766,581

**Applicant(s)**

UCHIYAMA, AKIO

**Examiner**

MATTHEW J. KASZTEJNA

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-50, 52-55, 57-59, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-50, 52-55, 57-59, 64 and 65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice of Amendment***

In response to the amendment filed on December 8, 2008, amended claims 47, 50, 53 and 55; canceled claims 51, 56, and 60-63; and new claims 64-65 are acknowledged. The following new and reiterated grounds of rejection are set forth:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 47-50, 52-55 and 57-59 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0139661 to Kimchy et al.

**In regard to claims 47 and 53**, Kimchy et al. disclose a medical apparatus 20 adapted for use with a capsulated medical device 12 having an imager for obtaining an image (see paragraph 0340) and an external reception system 18 placed outside of a body for receiving data of the image, the medical apparatus being operable with the external reception system (see Fig. 1a) and comprising: a communication section 46 through which the external reception system is connected (see paragraph 0338) and the data of the image is transmitted from the external reception system, the external reception system receiving data, via receiver 40, of the image wirelessly transmitted from the capsulated medical device through an antenna 54 and storing the received

data of the image in a storage section 36 (see paragraph 0363); a display section (not labeled, but seen in Figure 1B) which at least temporarily displays the image transmitted from the external reception system; and a drive power supply section including a battery for supplying a driving power to at least the communication section (see paragraph 0038). Kimchy et al. teach wherein the computer station 20 may be a personal computer, a minicomputer, a laptop, or the like. If a laptop is implemented in a system, then the drive power supply section would inherently include a battery for powering the system as is well known in the art. Furthermore, **in regard to claims 49 and 57**, it is well known in the art and is inherent that all personal computers include electric circuits adapted to generate direct-current voltage from AC power supply.

**In regard to claims 48 and 54**, Kimchy et al. disclose a medical apparatus, wherein the image comprises plurality of images and, when the medical apparatus is connected to the external reception system (see paragraph 0338), the display section displays at least some of the images which are stored in the external reception system (see paragraphs 0341-0342). Furthermore, Kimchy teach of numerous embodiments wherein a diagnostic image may comprise diagnostic information (nuclear radiation, optical fluorescence, infrared radiation etc.) as a function of time as seen in Fig 3a or diagnostic information as a function of distance traveled by the capsule 12, based on information see in Fig 3d.

**In regard to claims 50 and 55**, Kimchy et al. disclose a medical apparatus, wherein the display section displays the image to allow a user to monitor a status on an

operation of the imager to confirm whether the imager is obtaining the image (see Figs. 3a-d and paragraph 0363).

**In regard to claims 52 and 59**, Kimchy et al. disclose a medical apparatus, wherein the image is displayed on the display section while the data thereof is stored in the storage section (see paragraphs 0341-0342).

**In regard to claim 58**, Kimchy et al. disclose a medical apparatus, wherein the information includes information related to an image capturing operation performed by the imager (see Fig. 3d and paragraph 0373).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0139661 to Kimchy et al. in view of U.S. Patent Application Publication No. 2002/0093484 to Skala et al.

**In regard to claims 64-65**, Kimchy et al. disclose a medical apparatus 20 adapted for use with a capsulated medical device 12 having an imager for obtaining an image and an external reception system 18 placed outside of a body for receiving data of the image, the medical apparatus being operable with the external reception system (see rejections above) but are silent with respect to further comprising an adjusting portion which provides data for adjusting the image using the received image data and

wherein the data for adjusting the image includes data for correcting the position of the image. Skala et al. teach of an analogous endoscopic system and method that allows altering the display of an image stream, which may be produced for example by a swallowable capsule. A workstation accepts images acquired by the capsule and displays the images on a monitor as a moving image. A user, through for example a scrolling wheel of a pointing device, sends signals to the workstation which alter the display of the moving image. The changes in the display may include, for example, altering the display direction of the moving image, and altering the resolution or position of a captured image from the moving image. A data processor storage unit 19 stores a series of images recorded by a capsule 40. The images the capsule 40 records as it moves through a patients GI tract may be combined consecutively to form a moving image. This moving image may be displayed in a window on monitor 18. The moving image may be frozen to view one frame, speeded up, or reversed, and sections may be skipped, but any other method for viewing an image may be applied to the moving image. Furthermore, the system and method of the present invention may be used with systems allowing for real time viewing of other image data (see Figs. 1-3 and paragraphs 0018-0025). It would have been obvious to one skilled in the art at the time the invention was made to provide an adjusting portion in the system of Kimchy et al. to allow a user to control the position of an image on a display device in real time as taught by Skala et al.

***Response to Arguments***

Applicant's arguments filed December 8, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Kimchy et al. fail to disclose a display section wherein images are displayed "while the capsulated medical device is in the body", it is noted, that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Kimchy teach of numerous embodiments wherein a diagnostic image may comprise diagnostic information (nuclear radiation, optical fluorescence, infrared radiation etc.) as a function of time as seen in Fig 3a or diagnostic information as a function of distance traveled by the capsule 12, based on information see in Fig 3d. A plurality of images can thus be produced based on the information most desired and considered most relevant to the user. (It is noted, that as broadly as claimed, a graph similar to those seen in Figures 3b-d, 4b-d, 8b and 9b, constitute an image.) The main objective of the system of Kimchy et al. is to provide an ingestible device to travel in the gastrointestinal tract and perform a diagnostic image of the tissue therein (see paragraph 0316). This image is displayed via computer means 20 as previously stated. Kimchy et al. also teach of a tracking system 158, which measure the real-time position and orientation of one or more miniaturized sensors, so as to accurately track the spatial location of probes, instruments and other devices (See paragraph 0457). An

example of such a tracking system and a graphic display can be seen in Figs 14b-c wherein integrated count readings and location information is relayed to a personal computer for processing and visual presentation (see paragraphs 0459-0460). Furthermore, real-time imaging is considered well-known in the art, as evident by the disclosure of Skala et al. as rejected above. Thus, as broadly as claimed, Kimchy et al. meet the limitations of the recited claims wherein the display section displays images while the capsulated medical device is in the body.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739

2/4/09